

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Mark L. Yoseloff, et al.	Examiner:	Benjamin H. Layno
Serial No.	10/658,863	Group Art Unit:	3711
Filed:	September 9, 2003	Docket No.	PA0906.ap.US
Title:	BET WITHDRAWAL GAME WITH CARD POKER SIDE BET		

---

**NEW (REPLACEMENT) BRIEF ON APPEAL**

**MAIL STOP: APPEAL BRIEF - PATENTS**

P.O. BOX 1450

Commissioner for Patents

Alexandria, VA22313-1450

Sir:

This Replacement Brief on Appeal is being provided in triplicate to the US Patent and Trademark Office in response to the **FINAL** Office Action mailed September 9, 2004 and the 2d Notice of Non-Compliant Brief mailed 31 October 2005 and the Order remanding to the Examiner decided July 24, 2007 and the Examiner's Answer (**with a New Ground of Rejection**) dated 16 February 2011. Applicants withdraw the request for a **personal appearance** before the Board to argue the case, as the issues are now so clearly in Appellants' favor as to need no further explanation. **Appellants elect to proceed with the Appeal.**

The U.S. Patent and Trademark Office is hereby authorized to debit any costs and fees associated with this Petition to Deposit Account No. 50-1391.

Electronically transmitted in accordance with § 1.6(a)(4)

The undersigned hereby certifies that this Transmittal Letter and the paper or fee, as described herein, are being sent by Electronic submission to the United States Patent and Trademark Office addressed to Mail Stop: APPEAL BRIEF-PATENTS, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313, on 15 April 2011

By: 

MARK A. LITMAN

## **TABLE OF CONTENTS**

<b>REAL PARTY IN INTEREST.....</b>	<b>3</b>
<b>RELATED APPEALS AND INTERFERENCES.....</b>	<b>4</b>
<b>STATUS OF CLAIMS.....</b>	<b>5</b>
<b>STATUS OF AMENDMENTS.....</b>	<b>6</b>
<b>SUMMARY OF INVENTION.....</b>	<b>7-8</b>
<b>ISSUES.....</b>	<b>9</b>
<b>ARGUMENT.....</b>	<b>10-22</b>
<b>CONCLUSION.....</b>	<b>23</b>
<b>CLAIMS APPENDIX.....</b>	<b>24-28</b>
<b>EVIDENCE APPENDIX</b>	<b>29</b>
<b>RELATED PROCEEDINGS APPENDIX</b>	<b>30</b>

**REAL PARTY IN INTEREST**

The real party in interest is the assignee of the full right and title of the invention, Shuffle Master, Inc. having a principle place of business in Las Vegas, Nevada.

## **RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any proceedings in the US Patent and Trademark Office or in the Courts that have any relationship to this Appeal. There are no Appeals or Interferences in the US Patent and Trademark Office that have issues and subject matter content relevant or related to those in this Appeal.

**STATUS OF CLAIMS**

Claims 1-28, all of the claims in the Application have been rejected under various combinations of references under 35 USC 103(a) and are ON APPEAL. No claims have been allowed or withdrawn from consideration in this Application.

## **STATUS OF AMENDMENTS**

An Amendment after final rejection was filed on 17 October 2005. A single amendment to the claims was voluntarily made by Appellant to correct an obvious typographic error. That amendment was refused as “raising new issues” and requiring additional search and consideration.” As the Amendment was not the subject of a rejection, Appellant will wait for determination of the Appeal to correct the minor issue.

## **SUMMARY OF THE INVENTION**

1. (ON APPEAL) A method of playing a wagering game, comprising:

placing an initial multiple-part wager to participate in a first poker-type game;

**[Page 4, line 18 through Page 6, line 13]**

optionally placing a side bet wager to participate in a second poker-type game played against a pay table; **[Page 4, line 18 through Page 6, line 13]**

dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game; ; **[Page 4, lines 18-26]**

providing community cards to complete partial hands in the first poker-type game; and **[Page 4, lines 18-26]**

resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table. **[Page 3, line 23 through page 4, line 9]**

18. (ON APPEAL) A method of playing a live casino table card game with physical cards comprising:

placing an initial a multiple part wager to participate in a casino wagering first poker game against a pay table in which a partial hand of at least two cards is first dealt and later completed for each player; **[Page 4, line 18 through Page 6, line 13]**

placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player's partial hand; **[Page 4, line 18 through Page 6, line 13]**

dealing a partial hand of cards to each player; **[Page 4, lines 18-26]**

providing additional cards to complete each player's hand; and **[Page 4, line 18 through Page 6, line 13]**

resolving each player's wagers in the first poker game and the second poker-type game against two different pay tables. **[Page 3, line 23 through page 4, line 9]**

26. (ON APPEAL) A method of playing a wagering game against only pay tables, comprising:

placing an initial multiple part wager to participate in a first poker-type game against only a pay table; **[Page 4, line 18 through Page 6, line 13]**

optionally placing a side bet wager to participate in a second poker-type game played against a pay table; **[Page 4, line 18 through Page 6, line 13]**

dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial multiple part wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game; **[Page 4, lines 18-26; page 4, line 27 through page 6, line 13]**

providing community cards to complete partial hands in the first poker-type game; and **[Page 4, lines 18-26]**

resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table. **[Page 3, line 23 through page 4, line 9]**



## **SUMMARY OF THE OFFICE ACTION**

1. Claims 1, 2, 6, 8-11, 15, 18-21, and 24-28 Have Been Rejected under 35 USC 102(e) [New Ground of Rejection] As Anticipated by, or in the Alternative, Unobvious over de Keller (U.S. Patent No. 5,975,529)
2. Claims 22 and 23 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller.
3. Claims 3-5, 7, 12-14, 16 and 17 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller and Further in View of Breeding (specific Breeding Patent ambiguously cited).

## **ARGUMENT OF APPELLANTS**

1. Claims 1, 2, 6, 8-11, 15, 18-21, 24 and 25 Have Been Rejected under 35 USC 102(e) [New Ground of Rejection] As Anticipated by, or in the Alternative, Unobvious over de Keller (U.S. Patent No. 5,975,529)

### **RESPONSE TO THE NEW GROUND OF REJECTION**

The rejection asserts that Appellants are not entitled to priority for the term “community card” under 35 USC 120 to the original application filed **July 19, 1995**. The reason given in the rejection is that in the specification, the common card used by all players (i.e., clearly a community card) was a “wild card.” The rejection asserts, without substantive evidence, that “wild cards” cannot be community cards. This refusal to acknowledge Appellants’ right to priority for the term “community card” in the claims on Appeal is traversed. Appellants will show that the reason given by the USPTO for refusing antecedent basis, namely that the disclosed commonly shared “wild card” of the priority application cannot be a community card. **IS CLEAR ERROR. The background knowledge in the art clearly allows commonly shared “wild cards,” as disclosed in the priority chain of this application, to be a community card, and refers to such cards as community cards. The priority claim back to July 19, 1995 for the term “community card” must be granted, and the de Keller reference is removed as available prior art under 35 USC 102(e).**

The new ground of rejection asserts that there is no antecedent basis through the chain of priority applications that provides antecedent basis for the term “card” without modification by the term “wild.” It is asserted, in effect, that the disclosure of a “wild card” as a distinct communal card in the play of a casino wagering game does not provide antecedent basis for the claims in this application to recite a “card” and therefore the priority date asserted by Appellant does not provide antecedent basis so as to enable priority under 35 U.S.C. 120 to antedate the de Keller reference.

Appellant specifically traverses this new ground of rejection and the underlying law and analysis upon which the rejection is based.

The question at hand asserted by the New Ground of Rejection is believed to be whether or not the priority chain of applications cited by Appellants contains literal antecedent basis for a “[generic] card” to be used as a community card, when the uncontroverted evidence of record shows that the chain includes a disclosure of at least a “wild card.”

The New Ground of rejection asserts that as the community cards “...in LET IT RIDE [*sic*, LET IT RIDE™ stud poker], the **community cards each have a specific fixed value**, what ever value is printed on a community card, that is the value used by all players during game play.” It is asserted that because a “wild card” has a variable value, it is not a community card. That analysis is believed to be in error on a number of grounds.

First, the terms in the claims are “...providing community cards to complete partial hands in the first poker-type game; and...” The question must therefore be, does one skilled in the art limit the concept of “community cards” solely to specific value cards or is the concept of “wild cards” known by those of ordinary skill in the art to be within the concept of community cards.

Attached, as evidence contradicting the narrow definition asserted by the New Ground of rejection, is the definition of “Community Cards” from Wikipedia. That definition includes as an example of a Wild Card game, the game of Iron Cross. In that game, the last card turned over in a community set of playing cards is a wild card (used by each player as the most desirable value (suit and rank) appropriate for each set of player’s cards. In addition, the community card designated as a wild card may also make other cards (of equivalent rank) wild in the players’ hands.

Also included is a list of home community card poker games including “Lame Brain Pete” (a game which the attorney of record will admit to having played in his misguided youth) in which community cards also include as a wild card, the lowest ranked card in the community card set. This is another example that one skilled in the art understands that the terms community cards and wild cards may overlap and are not exclusive of each other.

**Therefore, one skilled in the art understands that the concept of a wild card used by all players (as found in the chain of applications from which Appellants claim**

**priority) can include a wild card according to rules of individual games.** The asserted interpretation of the term “wild card” as excluding a community card is in error. One skilled in the art has been shown to know from background information that community cards can include wild cards. As the priority chain shows a single card used by all players (a community card) that is a wild card, this attempt to exclude the claim from priority under 35 USC 120 for an erroneously asserted failing under 35 USC 112, (first and second paragraphs) is clearly in error. As Appellants’ priority includes the use of a wild card that is commonly used by all players (i.e., a community card), there is in fact antecedent basis for community card under 35 USC 112, first and second paragraphs in compliance with the requirements of 35 U.S.C. 120.

Secondly, the assertion that the disclosed concept of a commonly shared card (i.e., a common card or community card) that in a particular game is a wild card does not provide **conceptual support** for the term community card is in error. The legal standard as to whether a specification (in this case for priority under 35 U.S.S. 120) **supports** employment of a term in a claim has been defined in case law such as *In re Anderson*, 176 U.S.P.Q. 336 (C.C.P.A. 1973) as:

“...whether there is support in the specification for employment of the term in a claim; is the concept of carrying present in the original; disclosure?”

In the present issue before the Board of Appeals, the question is does the disclosure in Appellant’s priority chain of at least one distinct and separate card (which happens to be wild) that is used by each and every player at a table (i.e., a card common to all players or a community card by its very nature) sufficient antecedent basis for employing “community card” in the claims in this Appeal.

**Appellants assert that the concept of community card is clearly disclosed in the priority chain extending back to July 19, 1995.** As there is antecedent basis for employment of the term “community card” in the priority chain, and as Appellants have claimed priority under 35 USC 120 through that priority chain back to the July 19, 1995 date, that claim of priority antedates the de Keller reference. The de Keller reference is not available as prior art under 35 USC 102(e). The rejection must fail and must be reversed.

**Direct Traversal of the Substantive Content of the rejection as in the Original Brief  
on Appeal**

<b>RECITATION OF CLAIM 1</b>	<b>TEACHINGS OF deKELLER (5,975,529)</b>
A method of playing a wagering game, comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing a first multiple part wager to participate in a first poker-type game;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;...” <b>(Claim 1)</b>
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of ‘a’ the house payout schedule lists a series of poker rankings with corresponding pay-offs...”
dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first wager, <b><u>the partial hand for the first poker-type game being a complete hand for the second poker-type game;</u></b>	<b>As noted above, the play of deKeller is</b> “In Showdown Poker the object of the game is twofold: 1) to make a good poker hand using two cards and the three community cards.” <b>There is no payable for the partial hand – only the complete hand of 5-cards.</b>
providing community cards to complete partial hands in the first poker-type game; and	“...1) to make a good poker hand using two cards and the three community cards.”
resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.	In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of ‘a’ the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of ‘b’ the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot bet is a bet solely between the players. It is not a wager played against the house.

As can be seen in the fourth comparison box in the table above, deKeller uses five card hands both for a payable event and the Pot play event. This is in contrast to the fact that claim 1 recites that “, **the partial hand for the first poker-type game being a complete hand for the second poker-type game;**”

**CLAIM 26 WILL BE DISCUSSED OUT OF ORDER FROM INDEPENDENT CLAIM 18 BECAUSE OF THE NEAR IDENTITY OF ISSUES WITH THE ARGUMENTS OF CLAIM 1**

<b>CLAIM 26</b>	<b>deKELLER</b>
26. (PREVIOUSLY PRESENTED) A method of playing a wagering game against only pay tables, comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing an initial multiple part wager to participate in a first poker-type game against only a pay table;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;...” <b>(Claim 1)</b>
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of ‘a’ the house payout schedule lists a series of poker rankings with corresponding pay-offs...”
dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial multiple part wager, <b><u>the partial hand for the first poker-type game being a complete hand for the second poker-type game;</u></b>	<b>As noted above, the play of deKeller is</b> “In Showdown Poker the object of the game is twofold: 1) to make a good poker hand using two cards and the three community cards.” <b>There is no payable for the partial hand – only the complete hand of 5-cards.</b>
providing community cards to complete partial hands in the first poker-type game; and	“...1) to make a good poker hand using two cards and the three community cards.”

<p>resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.</p>	<p>In Showdown Poker the object of the game is twofold:</p> <ul style="list-style-type: none"> <li>a) to make a good poker hand and</li> <li>b) to win the Pot bets.</li> </ul> <p>In the case of 'a' the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of 'b' the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot bet is a bet solely between the players. It is not a wager played against the house.</p>
--	--

As can be seen, claim 26 clearly recites the fact that the second wager is based upon only the partial hand cards and a ranking of the partial hand cards **ONLY**. This feature is clearly not shown by deKeller and therefore is not anticipated or obvious from the teachings of deKeller.

#### **Additional and Separate Arguments on the Merits with Respect to Claims**

New Claim 26 reads (with **highlighted** changes from claim 1 emphasized):

26. A method of playing a wagering game **against only pay tables**, comprising:

- placing a first multiple part wager to participate in a first poker-type game **against only a pay table**;
- optionally placing a side bet wager to participate in a second poker-type game played against a pay table;
- dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first **multiple part** wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;
- providing community cards to complete partial hands in the first poker-type game; and
- resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.

#### **Separate and Individual Arguments on the Merits as to Why de Keller Does Not Anticipate Claim 1 and claims dependent therefrom.**

It is asserted in the Rejection that de Keller shows, with respect to original claim 1:

- 1) multiple part wagers (All players make bets of equal value in their respective pots, then place Bet 1 (Col. 2, lines 54-64, and Fig. 1, elements 5, 6 and 7);

- 2) An optional side bet bonus wager (Col. 5, lines 8-21);
- 3) At the beginning of each hand, each player is dealt two cards, although this number may vary, one face up and two down. (Col. 2, lines 58-63). Asserting that three cards as partial hands are obvious;
- 4) The three dealer's cards are community cards completing each player's hands (Col. 2, lines 63-66);
- 5) The first multi-part wager is resolved according to the rules of 5-card poker (Col. 4, lines 39-44) with a 5-card poker pay table (Col. 4, lines 53-56);
- 6) The optional side wager is resolved according to 3-card poker (Col. 5, lines 9-21); and
- 7) Each part of the wager is equal (Col. 2, lines 58-60).

Although the essence of some of these teachings in de Keller is correct, the underlying game of de Keller has numerous other requirements that should be emphasized as excluding anticipation and obviousness from de Keller. One important failure of de Keller under 35 USC 102(b) is the fact that de Keller does not place **initial** multiple part wagers. Applicants had thought that the term "first" was sufficient to emphasize that point, but have amended to claims to indicate by initial that these multiple part wagers are placed prior to the player viewing dealt cards. On this basis alone, every rejection under 35 USC 102(b) is in error, and there has been no showing of this limitation sufficient to teach modification of that limitation under 35 USC 103(a). The rejections are therefore in error.

Note also that claim 26 recites wherein the game has been limited to play against only pay tables. This provides a clear avoidance of de Keller who has competition against a pay table **and** player-versus-player. It also would not be obvious to eliminate the fundamental requirements of de Keller's game in which the multi-part wagers are required only because of the additional elements of the game.

Claim 27 focuses on the fact that the multi-part wagers are part of the same game and are resolved according to a single event in a single game. This strongly differentiates the subject matter of de Keller.

**It is asserted** that de Keller in view of Breeding teaches the limits of claims including "...withdrawal of a part of the multiple part wager before a first community



card is disclosed to the player, with the player remaining in play in the first poker-type game...” This issue may be more complex, for a number of reasons. Having distinguished de Keller for lacking multi-part wagers on the same game and playing against only pay table, Breeding teachings both of those elements, in addition to bet withdrawal.

<b>RECITATION OF CLAIM 18</b>	<b>deKELLER</b>
A method of playing a live casino table card game with physical cards comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing an initial a multiple part wager to participate in a casino wagering first poker game against a pay table in which a partial hand of at least two cards is first dealt and later completed for each player;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;...” <b>(Claim 1)</b>
<b><u>placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player’s partial hand;</u></b>	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of ‘a’ the house payout schedule lists a series of poker rankings with corresponding pay-offs...”
dealing a partial hand of cards to each player;	<b>This step in deKeller is performed before the second game and does not require using all cards in the partial hand.</b>
providing additional cards to complete each player’s hand; and	“...1) to make a good poker hand using two cards and the three community cards.”
resolving each player's wagers in the first poker game and the second poker-type game against two different pay tables.	In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of ‘a’ the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of ‘b’ the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot bet is a bet solely between the players. It is

not a wager played against the house.
---------------------------------------

deKeller does not teach or suggest the **highlighted** limitation in claim 18. deKeller has wagers for complete (e.g., best 5 of seven cards) and does not teach the limitation of “**placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player’s partial hand;**” As such, the rejection is in error and must be withdrawn.

**Argument against the Examiner’s Position That the Present Claims Lack Priority under 35 USC 120 for the Claimed Subject Matter.**

The sole basis for asserting that the claimed subject matter lacks priority under 35 USC 120 is that an intermediate application 08/504,023 lacks compliance with 35 USC 112, second and first paragraphs with respect to the use of “community cards” because:

- 1) the application teaches a single Wild Card that is used by all players; and
- 2) Wild Cards are not community cards because they are different values to each player.

The analysis of this issue of the effect of the Wild Card is in error. Community cards are card(s) common to every player at the table. The type, nature and use of that card are not fundamental to whether or not it is a community card or other cards are discarded or not. To show that this is common knowledge to one skilled in the art, Applicant cites the following knowledge in the public domain:

- 1) *Ainslie’s Complete Hoyle*, Ton Ainslie, Fireside Book, Simon & Schuster, New York, 1975, pp. 268-269; and
- 2) [www.Pogo.com](http://www.Pogo.com), online wagering at Club Pogo, Texas Hold’Em, Jokers Wild.

The first reference (Ainslie) is self explanatory. It shows that in at least one commonly known poker game, Wild Widow. In the play of Wild Widow, a single center card (as in Let It Ride taught in the 08/504,023 application is a wild card for every player, to be used in combination, as the individual players desire, with the other cards dealt to the players. Ainsle therefore shows that a single center wild card is a community card.

The Club Pogo site, which has been in place for at least 5 years, provides an on-line game room in which Texas Hold’Em poker and its variants are played. As is well

known, Texas Hold’Em is played with each player receiving two Hold Cards (pocket cards) and in staged events, five community cards. In a variant of Texas Hold’Em provided on Club Pogo’s site is a game called Jokers Wild. In that game, the standard 52-card deck is replaced with a 54-card deck having exactly two Jokers. Each Joker is wild. When one or more Jokers appears in the flop, 4<sup>th</sup> street or the River Card, each player uses each Joker in a manner to make the player’s hand the highest possible rank. The Flop, 4<sup>th</sup> street and the River Card constitute the totality of community cards used in the game. Again, this establishes that the use of a Wild card in a community card set may be used by each player in any way that individual player wants to make the player’s hand the best possible rank, independent of the suit or rank that Wild card is used by any other player. The use of the Wild card in the community card set consisting of the Flop, 4<sup>th</sup> street and the River Card clearly establishes that the Wild card is still a community card.

It is clear that the assertion that the teaching of a wild card in U.S. Patent Application No. 08/504,023 does not cause a failure in the stream of priority as asserted by the Final Office Action. To that end, as clearly indicated below, the claim for priority has been shown to meet the requirements of 35 USC 112, first and second paragraphs with regard to the single ground of objection proposed in the Final Office Action. With the following described priority chain being satisfactory, deKeller is not available as a reference, even if it provided an effective teaching against the claims, which it does not, as clearly shown above.

It still is believed that the de Keller reference is not available under 35 USC 102(b) as a reference in view of the priority date chain established for the present application. In this regard, the Examiner is requested to review the Table below showing priority for the concepts in the limitations in the claims from the earliest application in the priority chain, which application antedates the filing date of the de Keller reference.

RECITATION OF CLAIM 1	PRIORITY LANGUAGE IN
A method of playing a wagering game, comprising:	“Card-type games provide at least one player with the option of wagering against either a predetermined payout schedule, a

	dealer's hand, or both.” (Abstract)
placing a first multiple part wager to participate in a first poker-type game;	“(a) determining whether to place a first bet that the player's hand will be greater than a first predetermined rank, where a plurality of hands are ranked according to predetermined rules and the first bet is a fixed payout bet;” (Claim 1) “A method of playing a card game according to claim 23 wherein said card deck is a conventional card deck comprising at least fifty-two cards, and each hand comprises four cards and each player combines said wild card indicia with four indicia of playing cards to form a five card poker hand.” (Claim 24)
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	“(a) determining whether to place a first bet that the player's hand will be greater than a first predetermined rank, where a plurality of hands are ranked according to predetermined rules and the first bet is a fixed payout bet;” (Claim 1) and “(b) determining whether to place a second bet that the player's hand will beat the dealer;” (Claim 1)
dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;	“The card of FIGS. 4-6 has a dual function; in playing the game it is used as a wild card; subsequently the card can be taken away by the player and retained as a momento and also serves as a promotional item. In a three-card version of the game described above, a player may be provided with two standard cards and a wild card to form a three-card hand. Alternatively, at least one player may be provided with three cards and be permitted to discard one card in order to form his/her best three-card hand using the wild card. Similarly, in four and five-card versions of the game a wild card of the kind shown in FIGS. 4-6 may be issued to each player and to the dealer. The players and dealer then use the wild card repeatedly in conjunction with each four card hand dealt to them to make a five-card poker hand. In a five-card game each player and the dealer may substitute the wild card for any card in their hand to improve the five-card hand they hold. This

	has the result of creating higher hand values and adding excitement to the game. According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and a wild card as provided to each player.” <b>The additional card indicates that the original hand is only a partial hand.</b>
providing community cards to complete partial hands in the first poker-type game; and	“According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and a wild card as provided to each player.” <b>The single wild card to all players is a community card.</b>
resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.	“if the dealer's hand does not exceed the second predetermined rank, the bank paying each player an amount based on the second bet and returning the third bet to the player, or if the dealer's hand exceeds the second predetermined rank, comparing the dealer's hand in turn with that of each other player who placed the second bet and if the player's hand is higher, the banker paying the player an amount based on both the second and third bets, and if the player's hand is lower, the player forfeiting both the second and third bets to the banker; and (g) the banker paying the fixed payout bet in accordance with a predetermined scale to any player who placed the first bet and whose hand exceeds the first predetermined rank.” (Claim 1)

As can be seen, the concept of Claim 1 of the present application finds antecedent basis in parent application 08/504,023 and issued patent U.S. Patent No. 5,685,774 issued November 11, 1997, **but filed on July 19, 1995**. That filing date provides a date prior in time to the available reference date of the de Keller reference, which is that patent’s filing date of **September 11, 1995**. The de Keller reference is therefore not available as a reference under 35 USC 102(b) as it is not prior to the established priority date of the present application and claims.

Note that the original specification of this Application as filed stated and claimed priority as:

“This application is a continuation-in-part of U.S. Patent Application Serial No. 10/016,436, filed April 29, 2002, titled Player Banked Three Card Poker and Associated Games, which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/249,118 filed February 2, 1999 which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/170,092 filed October 13, 1998, now U.S. Patent No. 6,237,916 issued May 29, 2001, which is a continuation-in-part of U.S. Patent Application Serial No. 08/889,919 filed July 10, 1997 now U.S. Patent No. 6,056,641 issued May 2, 2000, which is a division of U.S. Patent Application Serial No. 08/504,023 filed July 19, 1995, now U.S. Patent No. 5,685,774 issued November 11, 1997.”

This priority date is established and is effective in overcoming the de Keller reference.

2. Claims 22 and 23 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller.

As the de Keller reference has been shown to be unavailable as a matter of law as a “prior art” reference under 35 USC 102(e), this rejection must fail for at least the same reasons described directly above.

3. Claims 3-5, 7, 12-14, 16 and 17 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller and Further in View of Breeding (specific Breeding Patent ambiguously cited).

As the de Keller reference has been shown to be unavailable as a matter of law as a “prior art” reference under 35 USC 102(e), this rejection must fail for at least the same reasons described directly above.

**CONCLUSION**

All rejections have been shown to be in error. As such, the application and claims are in condition for allowance.

Respectfully submitted,

MARK L. YOSELOFF, et al.

By Their Representatives,

MARK A. LITMAN & ASSOCIATES, P.A.

York Business Center, Suite 205

3209 West 76<sup>th</sup> Street

Edina, Minnesota 55435

(952) 832-9090

Date 15 April 2011

By: 

Mark A. Litman

Reg. No. 26,390

## APPENDIX – CLAIMS ON APPEAL

1. (CURRENTLY AMENDED) A method of playing a wagering game, comprising:
  - placing an initial multiple-part wager to participate in a first poker-type game;
  - optionally placing a side bet wager to participate in a second poker-type game played against a pay table;
  - dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial ~~[[wager]]~~ wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;
  - providing community cards to complete partial hands in the first poker-type game; and
  - resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.
2. (ORIGINAL) The method of claim 1 wherein a payout is made to the player on the side bet wager in the second poker-type game for one of a plurality of predetermined winning outcomes.
3. (PREVIOUSLY PRESENTED) The method of claim 2 wherein the rules of the first poker-type game allow at least partial withdrawal of a part of the initial multiple part wager before a first community card is disclosed to the player, with the player remaining in play in the first poker-type game.
4. (ORIGINAL) The method of claim 3 wherein the partial hand is exactly three cards, and a complete hand in the first poker-type game is five cards.
5. (PREVIOUSLY PRESENTED) The method of claim 4 wherein the first part multiple wager and the side bet wager are resolved according to a first pay table on the initial multiple part wager and a second pay table on the optional side bet wager.



6. (ORIGINAL) The method of claim 1 wherein the player is dealt a three-card partial hand, there are two community cards, and the optional side bet wager is against a pay table for three-card poker.
7. (ORIGINAL) The method of claim 6 wherein the player must make at least the initial multiple part wager a three-part multiple part wager, the two community cards are placed face down, and the player may remove one part of the at least three part wager before each community card is revealed from a face down position.
8. (ORIGINAL) The method of claim 6 wherein the game is a casino table card game.
9. (ORIGINAL) The method of claim 6 wherein the game is an electronic video wagering game.
10. (ORIGINAL) The method of claim 1 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
11. (ORIGINAL) The method of claim 2 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
12. (ORIGINAL) The method of claim 3 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
13. (ORIGINAL) The method of claim 4 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
14. (ORIGINAL) The method of claim 5 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
15. (ORIGINAL) The method of claim 6 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

16. (ORIGINAL) The method of claim 7 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

17. (ORIGINAL) The method of claim 6 wherein community cards are revealed one community card at a time, and each player is given an opportunity to withdraw one part of the multiple part wager before each community card is revealed.

18. (PREVIOUSLY PRESENTED) A method of playing a live casino table card game with physical cards comprising:

- placing an initial a multiple part wager to participate in a casino wagering first poker game against a pay table in which a partial hand of at least two cards is first dealt and later completed for each player;

- placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player's partial hand;

- dealing a partial hand of cards to each player;

- providing additional cards to complete each player's hand; and

- resolving each player's wagers in the first poker game and the second poker-type game against two different pay tables.

19. (ORIGINAL) The method of claim 16 wherein at least some payouts proportional to the optional single part wager are available in resolving hands for obtaining a predetermined rank of a hand.

20. (CURRENTLY AMENDED) The method of claim 16 comprising placing a three part wager as the initial multiple part wager in the first poker game and receiving three cards as the partial hand.

21. (ORIGINAL) The method of claim 18 wherein the partial hand of a player is completed with at least two community cards.

22. (ORIGINAL) The method of claim 19 wherein proportional payouts for the optional side bet wager include possible payouts of between at least 1 to 1 and 100 to 1 against the optional single part wager.

23. (ORIGINAL) The method of claim 20 wherein the proportional payouts include at least two possible payouts of at least 10 to 1.

24. (ORIGINAL) The method of claim 18 where community cards are provided.

25. (ORIGINAL) The method of claim 18 where additional cards are dealt to each hand.

26. (PREVIOUSLY PRESENTED) A method of playing a wagering game against only pay tables, comprising:

- placing an initial multiple part wager to participate in a first poker-type game against only a pay table;

- optionally placing a side bet wager to participate in a second poker-type game played against a pay table;

- dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial multiple part wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;

- providing community cards to complete partial hands in the first poker-type game; and

- resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.

27. (PREVIOUSLY PRESENTED) The method of claim 26 wherein wagers in the first poker-type game and wagers in the second poker-type game are resolved at the same time after completion of the partial hand.

28. (PREVIOUSLY PRESENTED) The method of claim 26 wherein wagers in the first poker-type game and wagers in the second poker-type game are resolved at separate times, with the wager in the second poker-type hand resolved after completion of the partial hand.

## **EVIDENCE APPENDIX**

Neither Appellants nor their counsel in this Appeal are aware of any secondary or supplemental evidence submitted during the prosecution of this Application that must be considered by the Board of patent Appeals in this decision.

## **RELATED PROCEEDINGS APPENDIX**

Neither Appellants nor their counsel on this Appeal are aware of any proceedings before the US Patent and Trademark Office or any US Judicial or Quasi-Judicial authority that relates directly towards any issues in this Appeal.